

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIA D. ELLUL
and
DONALD R. HAZELTON

MAILED

MAR 28 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2002-0789
Application No. 08/780,507

HEARD: February 5, 2003

Before WALTZ, DELMENDO, and POTEATE, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claims 17 through 19 (final Office action of Feb. 8, 2001, paper 4), which are all of the claims pending in the above-identified application.

The subject matter on appeal relates to a composition for preparing a thermoplastic elastomer. Further details of this

appealed subject matter are recited in representative claim 17 reproduced below:

17. A composition for preparing a thermoplastic elastomer, which comprises (A) 24 wt.% of propylene homopolymer principally containing propylene units of exactly alternating configuration and having a syndiotactic pentad fraction of 0.86 and (B) 76 wt.% of an ethylene-propylene-diene copolymer containing 48% ethylene content, and 0.39 parts per 100 based on the sum of (A) and (B) of α - α ¹-bis(t-butyl peroxy)diisopropyl benzene.

The examiner relies on the following prior art reference as evidence of unpatentability:

Masuda et al. 5,525,675 Jun. 11, 1996
(Masuda)

Claims 17 through 19 on appeal stand rejected under 35 U.S.C. § 102(e) (2002) as anticipated by Masuda. (Examiner's answer of Sep. 11, 2001, paper 11, pages 3-5.)

Because the appellants have not established an earlier effective filing date for the subject matter defined by the appealed claims, we affirm.¹

The appellants concede that Masuda "anticipates or at least renders obvious" the subject matter of appealed claim 17.

(Appeal brief filed Jul. 6, 2001, paper 10, page 3.)

Nevertheless, it is the appellants' position that Masuda is not

¹ The appellants submit that the appealed claims stand or fall together. We therefore confine our discussion to claim 17. 37 CFR § 1.192(c) (7) (1997).

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available as prior art under 35 U.S.C. § 102(e) because the subject matter of appealed claim 17 is "found throughout Appllants' [sic] chain of parent applications." (Appeal brief, page 6.)

We cannot agree. For a claim in a later filed application to be entitled to the benefit of an earlier filing date of a previously filed application under 35 U.S.C. § 120 (2002), the previously filed application must comply with the written description requirement of 35 U.S.C. § 112, ¶1 (2002). Tronzo v. Biomet, Inc., 156 F.3d 1154, 1158, 47 USPQ2d 1829, 1832 (Fed. Cir. 1998) (citing Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997)). In a case where there is a chain of applications, each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112, ¶1. Lockwood, 107 F.3d at 1571, 41 USPQ2d at 1965-66.

Facially, Masuda is available as prior art under 35 U.S.C. § 102(e) because the Masuda application was filed Mar. 23, 1994, which is before the filing date of the present application. Although the present application is a continuation-in-part of earlier application 08/619,135 filed Mar. 20, 1996, which is a continuation of earlier application 08/390,906 filed Feb. 16, 1995, which in turn is a continuation of earlier application

08/206,984 filed Mar. 4, 1994, the appellants have not satisfactorily established that each of the earlier applications complies with the written description requirement of 35 U.S.C. § 112, ¶1, as to the now claimed subject matter. Specifically, appealed claim 17 recites a genus or subgenus of polymers in "propylene homopolymer principally containing propylene units of exactly alternating configuration and having a syndiotactic pentad fraction of 0.86." The appellants, however, have not established where in the earlier applications this genus or subgenus of polymers is described within the meaning of § 112, ¶1.

The appellants urge that Example 1 of the earlier applications supports the now claimed genus or subgenus of polymers. We are not persuaded by this argument. While Example 1 of the earlier applications describes the use of a specific syndiotactic polypropylene homopolymer identified as "Grade G49M, Hoechst AG" having a syndiotacticity of 0.86, the now claimed subject matter also encompasses other propylene polymers having the same syndiotacticity but with markedly different structures including polymers having other molecular weights (melt indices), molecular weight distributions, comonomer compositions, and/or densities. We do not think that the prior applications, which disclose only this specific syndiotactic

homopolymer (Grade G49M, Hoechst AG), contain sufficient blazemarks to satisfy the written description requirement as to the subject matter of appealed claim 17, which reads on an almost infinite genus or sub-genus of syndiotactic polypropylenes having a syndiotactic pentad fraction of 0.86.

In re Lukach, 442 F.2d 967, 968, 169 USPQ 795, 796 (CCPA 1971) ("[W]here an applicant claims, as here, a class of compositions, he must describe that class in order to meet the description requirement of the statute."); accord Fujikawa v. Wattanasin, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996).

The appellants rely on the holdings of Kennecott Corp. v Kyocera Int'l Inc., 835 F.2d 1419, 5 USPQ2d 1194 (Fed. Cir. 1987) and In re Nathan, 328 F.2d 1005, 140 USPQ 601 (CCPA 1964) as controlling authority. (Appeal brief, pages 6-7.) However, we agree with the examiner (answer, page 5) that these precedents are inapposite to the facts of the present case. In Kennecott, our reviewing court held that the disclosure in a subsequent application of an inherent property of a product disclosed in the earlier application does not deprive that same product of the benefit of an earlier filing date. Kennecott, 853 F.2d at 1423, 5 USPQ2d at 1198. Similarly, the predecessor of our reviewing court in Nathan held that an amendment of a product claim to recite an inherent characteristic of the

product (established by way of an affidavit) does not violate the written description requirement. Nathan, 328 F.2d at 1008, 140 USPQ at 604. By contrast, appealed claim 17 is not limited to the same product ("Grade 49M, Hoechst AG") described in the prior applications. Accordingly, there is a crucial difference between the facts of the present appeal and those of the precedents.

The appellants argue (reply brief filed Nov. 13, 2001, paper 14, page 3):

[E]ach of the syndiotactic propylene homopolymers disclosed, that is each species disclosed, has a syndiotactic pentad fraction of 0.86 or 0.87. The species having the syndiotactic fraction of 0.86 is that which is used in the examples recited in the three claims on appeal. Thus, since a pentad fraction of 0.87 or 0.86 could be used within the scope of the disclosed invention, including the invention of Masuda, it would be proper to state that all species disclosed in Appellants [sic] application on appeal as well as parents thereof, do describe a single structure.

This argument lacks merit. The other polypropylene homopolymer species disclosed in the prior applications (Grade G53, Hoechst AG and Grade G20/28, Hoechst AG) have a syndiotactic pentad fraction of 0.87, which is outside the scope of appealed claim 17. The disclosure of species outside the scope of appealed claim 17 cannot possibly constitute a basis to satisfy the written description requirement as to appealed claim 17 and, in

fact, vitiates the appellants' position that "all species disclosed in Appellants [sic] application on appeal as well as parents thereof, do describe a single structure." (Id.) The only relevant disclosure in the prior applications as to the now claimed subject matter is the disclosure of Grade 49M, Hoechst AG. As we discussed above, however, the disclosure of this single species is insufficient to support the potentially infinite genus or subgenus recited in appealed claim 17.

Because the appellants have not established an earlier filing date for the claimed subject matter prior to Mar. 23, 1994, we see no reversible error in the examiner's ultimate decision to reject the appealed claims under 35 U.S.C. § 102(e) as anticipated by Masuda.

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Thomas A. Waltz

Thomas A. Waltz
Administrative Patent Judge)
) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES
Romulo H. Delmendo)
Romulo H. Delmendo)
Administrative Patent Judge)
)
)

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POTEATE, Administrative Patent Judge, dissenting:

Regretfully, I cannot join the decision of the majority holding that Matsuda is available as prior art under 35 U.S.C. § 102(e). (Slip. op. at page 3.)

The examiner found that Masuda discloses the invention as claimed. Examiner's answer, paper no. 11, mailed 13 September, 2001, page 3, paragraph (10). "Appellants' do not question that Masuda et al. anticipates or at least renders obvious Appellants' claims." Appeal brief, paper no. 10, received July 6, 2001, page 3. Rather appellants urge that they are entitled to the benefits of the filing dates of their parent applications for the claims on appeal, the first filed application having a filing date of March 4, 1994. Id. If appellants' claims are entitled to this filing date, then Masuda, which has a later filing date of March 23, 1994, is not a prior art reference within the meaning of 35 U.S.C. § 102.

Thus, the issue in the present case is whether the application filed March 4, 1994 provides an adequate written description of the claimed compositions as required by 35 U.S.C. § 112, ¶ 1. More specifically, the issue is whether appellants' March 4 patent application supports the claimed "propylene homopolymer principally containing propylene units of exactly

alternating configuration and *having a syndiotactic pentad fraction of 0.86.*"

The function of the description requirement is to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. To comply with the description requirement it is not necessary that the application describe the claimed invention in *ipsis verbis*; all that is required is that it reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him. In the context of the present case, this translates into whether the parent application provides adequate direction which reasonably leads persons skilled in the art to the later claimed compound. By the very nature of this inquiry, each case turns on its own specific facts.

In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978) (citations omitted).

Appellants primarily rely on Example 1 of the parent applications as providing an adequate written description of the presently claimed propylene homopolymer. According to appellants, the same polypropylene "1" used in Example 1 of the present application was used in Example 1 of the parent applications. See Appeal brief, page 4. In the parent applications, polypropylene "1" is defined as "syndiotactic homopolymer [grade G49M, Hoechst AG]." Id. The present application includes the additional description of the syndiotactic, polymer "having a syndiotactic pentad fraction of

0.86." Id. Appellants maintain that because the specific grade or source of syndiotactic polypropylene "1" (i.e. grade G49M, Hoechst AG) has a syndiotactic pentad fraction of 0.86, the additional information added to the present application merely states an inherent characteristic of the syndiotactic polypropylene "1" identified in appellants' parent applications.

Appeal brief, page 5.²

The majority concedes that Example 1 of the parent applications "describes the use of a specific syndiotactic polypropylene homopolymer identified as 'Grade G49M, Hoechst AG' having a syndiotacticity of 0.86." (Slip Op., page 5). However, the majority concludes that the claims are not supported by the parent applications because the compositions as claimed encompass other propylene polymers having the same syndiotacticity but with markedly different structures. Id.

² To prove inherency, the burden is on appellants to show that the missing descriptive material is necessarily present in the prior disclosure, not merely probably or possibly present. See Trintec Industries, Inc., v. Top-U.S.A. Corp. 295 F.3d, 1292, 1295, 63 USPQ2d, 1597, 1599 (Fed. Cir. 2002); Kennecott Corp. v. Kyocera Int'l, Inc., 835 F.2d 1419, 1423, 5 USPQ2d 1194, 1198 (Fed. Cir. 1988), cert. denied, 486 U.S. 1008 (1988). Appellants maintain that one of ordinary skill in the art, upon reading the parent applications would have known that the polypropylene "1" disclosed therein had a syndiotactic pentad fraction of 0.86 simply by asking the manufacturer or by analyzing the material for this value. See Reply brief, paper no. 12, received November 13, 2001, page 2.

According to the appellants, they have discovered that by incorporating a syndiotactic polypropylene homopolymer into olefinic thermoplastic elastomers in combination with an olefin rubber component they achieve a thermoplastic elastomer composition having the property of optical translucence, while maintaining the desirable properties of low compression set and thermal stability. Specification, page 3. The specification provides that "[t]he stereochemistry of syndiotactic polypropylene is generally described as one in which the polymer principally contains units of exactly alternating configuration. . . . Syndiotactic polypropylene homopolymer has a density in the range of 0.89-0.91 g/cm³ and a melting point in the range of 135-140 °C." Id., pages 3-4.

Although I agree with the majority that the claims as drafted encompass propylene polymers having the same syndiotacticity as polypropylene "1" but with different structures, in my view, the disclosure in the parent applications provides sufficient guidance to direct the reader to the claimed compositions. In particular, it is my understanding that "[s]yndiotactic polypropylene homopolymer [having] a density in the range of 0.89-0.91 g/cm³ and a melting point in the range of 135-140 °C" (specification, page 3) and *having a syndiotactic pentad fraction of 0.86* will have certain

physical properties as a result of the degree of syndiotacticity irrespective of differences in sources/grades.³ Thus, although the specification only includes an example of one grade of homopolymer having a syndiotacticity of 0.86, it nonetheless provides guidance to one of ordinary skill in the art to select other propylene homopolymers *having a syndiotactic pentad fraction of 0.86* to achieve a thermoplastic elastomer composition having the desired properties.

Having found that the language reciting the specific pentad fraction of the syndiotactic homopolymer recited in claims 17-19 is fully supported by the parent applications, I conclude that Masuda is not a prior art reference within the meaning of 35 U.S.C. § 102(e). Accordingly, I respectfully dissent.

Linda R. Poteate
LINDA R. POTEATE
Administrative Patent Judge

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APPEALS AND
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³ See, e.g., U.S. Patent No. 5,340,892, col. 8, lines 44-52 ("[A]ccording to the process of the present invention, styrene polymers having syndiotactic configuration of especially high tacticity with a wide molecular weight distribution can be produced by a simple process. Such styrene polymers are excellent in physical properties such as heat resistance because of high syndiotacticity, have a wide molecular weight distribution and can be used suitably for hollow molding, sheet and film molding.")

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